

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No. : 6,112,514
Issued : September 5, 2000
Application No. : 09/159,634
Filed : September 24, 1998
For : Fan Noise Reduction From Turbofan Engines Using Adaptive Herschel-Quincke Tubes

DECLARATION OF MARK COBURN

I, Mark Coburn provide this Declaration in support of the Petition To Accept Delayed Payment of a Maintenance Fee Under 37 C.F.R. § 1.378(b) for U.S. Patent No. 6,112,514.

I hereby declare that:

1. I am a U.S. citizen, of legal age, and resident of Blacksburg, Virginia. The statements in this declaration are based on my own personal knowledge and belief.
2. I am President of Virginia Tech Intellectual Properties, Inc. ("VTIP") (assignee of the above-identified patent). I have been employed in this capacity since March 27, 2006. My employment at VTIP includes managing the technology transfer office associated with Virginia Polytechnic and State University ("Virginia Tech") including all aspects of managing the application, prosecution, issuance and maintenance of US and foreign patent applications based on invention disclosures submitted by employees of Virginia Tech. The work includes the licensing of such intellectual property to companies who use the intellectual property as a basis for developing a product or service which benefits society.
3. I have an A.B. degree in Zoology from Miami University (Ohio) and an M.S. degree in Technology Management from Pepperdine University (Graziadio School of Business and Management). My background includes thirteen years at the University of Southern California (1978-1991) where I served as deputy director in the research administration office and another six years at the University of California Santa Cruz (1991-1997) where I was director of sponsored

projects/patent coordinator. I played a founding role in the development of the Monterey Bay Education, Science and Technology Center, part of the reuse of the Fort Ord military reservation, and served as that organization's director of business planning and development. Previous to my current position as President of VTIP I served as Director, Office of Research and Project Administration (1997-1999) and Associate Provost and Director for the Office of Technology Transfer (1999-2006) at the University of Rochester.

4. Part of my responsibilities at VTIP includes tracking and managing the intellectual property owned by VTIP. To assist me with this responsibility VTIP licenses and uses Inteum C/S ® technology transfer software for intellectual property. Inteum C/S is recognized in the industry as an excellent management tool for tracking patent due dates including maintenance fee due dates and is in use at over 400 sites worldwide. VTIP has licensed and used Inteum C/S for over ten years.

5. Previous to 01 May 2008 Whitham, Curtis, Christofferson & Cook P.C. was responsible for tracking and payment of maintenance fees for VTIP patents. On 01 May 2008 VTIP took over responsibility for tracking and payment of maintenance fees for VTIP's US patents. Since 01 May 2008 I am responsible for tracking and overseeing payment of US maintenance fees for VTIP patents.

6. VTIP has used Inteum C/S and its predecessor version DEALS since March 1997 to track due dates relating to patent matters. I used the Inteum C/S program in relation to my work at the University of Rochester and at the University of California Santa Cruz. Up to 01 May 2008 only one error in payment of VTIP patent maintenance fees had occurred (see explanation at paragraph 3 of accompanying Declaration of Michael E. Whitham).

7. VTIP and I have come to rely on Inteum C/S as a reliable tracking tool.

8. In anticipation of VTIP becoming responsible for the payment of VTIP's maintenance fees we prepared for implementation by taking the following steps:

- Prior to about 01 May 2008 the VTIP Inteum C/S report did not include US patent maintenance fee tracking information. Just prior to about 01 May 2008 I implemented the appropriate commands to the Inteum C/S system to add maintenance fee docketing information to the Inteum C/S report.
- An Inteum C/S report was run and the accuracy of the US patent maintenance fee due dates was confirmed. Thereafter the Inteum C/S reports included the maintenance fee due date for the US patents that are assigned to VTIP.

9. When, on about 01 May 2008 I first became responsible for the payment of VTIP's maintenance fees we implemented the following steps to ensure prompt payment:

- We confirmed that Whitham, Curtis, Christofferson & Cook P.C. had paid all US patent maintenance fees that they were instructed to pay.
- Using the Inteum C/S database that has served us successfully for years VTIP began generating a monthly report (an example is attached as Exhibit A) listing the status of maintenance fees for VTIP patents.
- I began regular review of the Inteum C/S database listing of the status of maintenance fees for VTIP patents and based on my review ordered payment of the outstanding maintenance fees coming due or in the case of a sponsor or licensee which has been granted the responsibility for paying the fee, verification that the fee has been paid. Payment of the fee is made using the USPTO online payment site using a VTIP corporate American Express card. VTIP began paying US patent maintenance fees that were coming due.
- An entry is made in the Inteum C/S database to that effect or if a decision was to not pay the fee, such decision is also recorded in the database.
- The Inteum C/S database is routinely (at least monthly) reviewed by me to determine if any maintenance fee payment is beyond the due date (and into the grace period for payment with a surcharge). Any such maintenance fee for a VTIP US patent is promptly paid with the surcharge.

10. On about 15 November 2011 I became aware that the second maintenance fee for the above noted '514 patent had not been paid. This was brought to my attention as we were preparing to pay the third maintenance fee due for the '514 Patent which was due for payment without surcharge by 05 March 2012. In reviewing the payment information it was observed that the U.S. Patent and Trademark Office had listed the status of this patent as expired for non-payment of maintenance fees. I immediately began review of this matter and shortly thereafter it became clear that the second maintenance fee had not been paid so I authorized the Senior Licensing Associate here at VTIP to find appropriate legal counsel for repair of the missed maintenance fee. The Senior Licensing Associate reported and Richard Lazarus at Barnes & Thornburg was contacted for assistance. Richard Lazarus was subsequently retained to investigate the facts surrounding the failure

to pay the second '514 maintenance fee, to determine if acceptance of late payment of the maintenance fees for the '514 patent was possible and, if so, to take appropriate action.

11. Richard Lazarus promptly began investigation of the failure to pay the second maintenance fee for the '514 patent. He requested review and a copy of all VTIP's records relating to payment of maintenance fee for the '514 patent. I have reviewed the VTIP records and determined that the only existing records are the Inteum C/S tracking report (copy attached as Exhibit A), the 09 August 2006 letter from Michael Whitham to me (copy attached as Exhibit B) and the Inteum C/S IP Assets screen shot (copy attached as Exhibit C).

12. The tracking report (Attachment A) lists the VTIP patents being tracked in the "Patent No." column, shows when the next maintenance fee is due in the "Sub Type" column and shows the task in the "Task" column. All "Patent" numbers and "Serial" numbers except for the '514 patent have been redacted to maintain confidentiality of those patents and applications. The '514 patent is listed on page 11 of 11 where it shows that the next maintenance fee due is the 7 and ½ year fee (indicated by "7.5" in the Sub Type column) and also indicates "Paid 8/9/06" (in the "Task" column). The "Paid 8/9/06" indicator was erroneously entered by Debra Lucas. As indicated at paragraph 7 of her Declaration (signed 17 January 2011) Debra reviewed a copy of the 09 August 2006 letter from Michael Whitham to Mark Coburn (Exhibit B accompanying this Petition) informing Mark of the authorization to pay the 2006 annuity fee for European Patent Application No. 99964945.2 and she acknowledges her handwriting in the upper right hand corner stating "97.058" (the "Tech ID" e.g., VTIP indicator for the applications for this invention at VTIP) and "C/S updated" (which indicates the updated entry into the Inteum C/S database). At paragraph 8 of her Declaration Debra states

it is my opinion that I erroneously entered the "Paid 8/9/06" entry on the VTIP Inteum C/S tracking report of the '514 patent (copy attached as Exhibit A) and I erroneously entered the "Paid 8/9/06" entry on the Inteum C/S IP Assets screen shot for Tech ID 97.058 (Exhibit C accompanying this Declaration). The "Paid 8/9/06" entry is erroneous since the entry is on the tracking report and screen shot for the corresponding US Patent (number 6,112,514) and should have been made instead for the corresponding European Patent Application (No. 99964945.2). I should not have made this entry for the US '514 patent and I have no recollection of why I made this entry.

13. I was responsible for ordering payment of the maintenance fees for VTIP patents. I do not recall and can find no record of ordering payment of the '514 second maintenance fee but I have

inquired to be sure that I had not ordered payment. A Declaration of Michael Whitham at Whitham, Curtis, Christofferson & Cook P.C. accompanies the petition and explains that a search of the files of Whitham, Curtis, Christofferson & Cook P.C. confirms that their files contain no evidence of receipt of instructions to pay the second maintenance fee for the '514 patent. Based on my review of the status of the '514 patent it is my opinion that I did not order payment of the second maintenance fee for the '514 patent. If the "Paid 8/9/06" indicator had not been in the record I believe I would have ordered payment of the US maintenance fees and the '514 patent would not have expired. I believe Debra Lucas made the erroneous "Paid 8/9/06" entry but I do not know why she made this entry.

14. As President of Virginia Tech Intellectual Properties I am the manager who supervised Debra Lucas from March of 2006 until she left VTIP in June of 2007. She was well trained and performed her work very well. Debra Lucas had worked at VTIP for several years prior to my arrival in March of 2006 and she had achieved a status of a trusted and reliable employee. She was familiar with the Inteum C/S data base and based on her work with me at VTIP I readily state that she was a reliable employee that could always be counted on to perform her duties correctly and on time. I am not aware of any other error made by Debra Lucas that resulted in entry of misinformation into the Inteum C/S data base so as to cause a US patent maintenance fee payment to be missed.

15. In reviewing the failure to pay the second maintenance fee for the '514 patent we have searched VTIP records for any reminder letters (of payment coming due or of expiration for failure pay a maintenance fee) from the USPTO for the '514 patent and none have been found. Further I have asked Whitham, Curtis, Christofferson & Cook P.C. to review their file for any such notice in order to provide a complete record with the petition to accept an unavoidably delayed maintenance fee payment. Michael Whitham's signed declaration accompanies the petition and states, in effect, that no Notice of Patent Expiration was found in their file and no notice of payment coming due for the '514 patent was in their file.

16. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Mark Coburn
Mark Coburn

1-27-12
(date)

Attachments: Inteum C/S tracking report (copy attached as Exhibit A)

09 August 2006 letter from Michael Whitham to Mark Coburn (copy attached as Exhibit B)

Inteum C/S IP Assets screen shot (copy attached as Exhibit C)